REMARKS

This is intended as a full and complete response to the Office Action dated November 19, 2004, having a shortened statutory period for response set to expire on February 19, 2005. Please reconsider the claims pending in the application for reasons discussed below. Claims 1-25 are pending in the application. Claims 1, 5, 9, 14, and 21 have been amended pursuant to the recent telephonic interview conducted between the Applicants and Examiner. Claims 1-25 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 102

Claims 1-11, 13, 14, 16-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Philips et al. (US 5,321,828, hereinafter Philips). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim,... In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, Philips does not disclose "each and every element as set forth in the claim". Specifically, Philips does not disclose, at least, a breakpoint counter which is not limited by a predetermined number representative of a desired number of encounters of the given breakpoint.

Claims 1, 5, 9, and 14 describe incrementing a counter which always reflects a current number of times a given breakpoint has been encountered. The claims also describe that the counter is not limited by a predetermined number representative of a desired number of encounters of the given breakpoint.

Examiner cites Philips at Col. 28, Line 50 to Col. 29, Line 8 for the proposition of automatically counting a number of times each breakpoint in an application is encountered while the application is executing during a test run. The cited section

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describes commands issued to a debugger program. Specifically, the cited section refers to a command "ignore <bnum> <count>" and "cont <count>". *See Philips,* Col. 29, Lines 4-18. The "ignore" command sets the ignore count of a breakpoint number to a count *entered by the user. Id.* When the breakpoint is reached, the "cont" may be given *by the user* to set the ignore count to another value. *Id.* With either instruction, for the next <count> times the breakpoint is reached, the debugger will not stop. *Id.* Thus, the cited section cites a number that is entered *by the user* and decremented until the number is zero. *Id.*

Because the count in *Philips* is entered by the user and is a number representative of a desired number of encounters of the given breakpoint, *Philips* does not describe a counter which is not limited by a predetermined number representative of a desired number of encounters of the given breakpoint, as claimed. Also, the cited sections of *Philips* refer to *decrementing* the number until it is zero. *See Philips,* Col. 29, Lines 1-2. Thus, *Philips* does not disclose incrementing a counter each time a breakpoint is encountered. Furthermore, before the breakpoint has been encountered in *Philips,* the count in *Philips* is a number entered by the user. *See Philips,* Col. 29, Lines 4-18. Though the breakpoint may have been passed several times, the count in *Philips* is zero when the breakpoint is activated. *Id.* Therefore, *Philips* does not describe a counter which always reflects a current number of times a given breakpoint has been encountered.

Claims 4, 9, and 14 also describe resetting the counter each time an application code segment is entered. *Philips* describes that the user may enter the <count> value for a single breakpoint, and that the <count> value is decremented. *See Philips,* Col. 29, Lines 1-18. *Philips* does not refer to resetting the counter each time an application code segment is entered. *Id.* Thus, *Philips* does not disclose each of the elements of the pending claims.

Because *Philips* does not disclose all of the elements of the pending claims, *Philips* is not an anticipating reference and Applicants respectfully request that the rejections with respect to claim 1, 4, 9, and 14 be withdrawn. With respect to the rejection of claims 2-8, 10-11, 13, 16-18 and 20, each rejection depends on Examiner's analysis given with respect to *Philips.* Applicants believe that *Philips* has been

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overcome for the reasons described above. Accordingly, withdrawal of the rejection is respectfully requested.
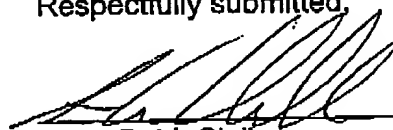
Claim Rejections - 35 U.S.C. § 103

Claims 15, 19, and 21-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Philips* further in view of other references cited by Examiner. With respect to the use of *Philips* in rejecting the claims, Examiner uses the same analysis provided with respect to claims 1-11, 13-14, 16-18 and 20. Applicants believe *Philips* has been overcome for the reasons stated above. Accordingly, withdrawal of the rejections is respectfully requested.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

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